

**IN THE DRAWING**

Please replace the original 16 sheets of drawing with the attached replacement sheets.

## REMARKS

Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37 through 42, 44 through 46, 48 through 53, 55 through 57, 59, 60, 70, 72 and 73 are pending in the application. Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, 28, 29, 33 through 35, 38 through 40, 42, 44 through 46, 49 through 51, 55 through 57, 60, 71 and 72 have been amended. Claims 2 through 4, 7 through 9, 11 through 13, 16 through 18, 20 through 22, 25 through 27, 32, 36, 43, 47, 54, 58, 61 through 69 and 71 have been canceled without prejudice or disclaimer. Claim 73 is newly added. Reconsideration of this application is respectfully requested.

At paragraph 3.1, the Office Action requires corrected drawing sheets. Replacement drawing sheets, corrected per paragraph 3 of the Office Action, are appended hereto subject to the Examiner's approval.

At paragraph 5, the Office Action objects to the specification on the ground that there is no support for the phrase, "at least one character group disposed in a plurality of character positions", which appears in claims 1- 48. This objection is moot as to claims 2 through 4, 7 through 9, 11 through 13, 16 through 18, 20 through 22, 25 through 27, 32, 36, 43, 47, which have been canceled. The Examiner states that the specification does support the phrase, "a sequence of individual characters". Independent claims 1, 10, 19, 28, 39 and 50 have been amended by replacing "character group" with "a sequence of characters". Accordingly, it is submitted that the amendment obviates the objection to the specification and, therefore, that the objection should be withdrawn.

At paragraph 6, the Office Action rejects claims 1 through 72 under the second paragraph of 35 U.S.C. 112 as indefinite. This rejection is moot as to claims 2 through 4, 7 through 9, 11 through 13, 16 through 18, 20 through 22, 25 through 27, 32, 36, 43, 47, 54, 58, 61 through 69 and 71, which have been canceled.

At paragraph 6.1, the Examiner notes that the indefiniteness is because “there is no clear and definite interconnection between one or more of the recited limitations of these claims”. The Examiner is confusing breadth with indefiniteness. For example, amended independent claims 28, 39 and 50 (noted at items I and J of paragraph 6.1) each recite a step (a) of assigning first and second positional palettes to first and second ones of the plurality of character positions and a step (b) of assigning alphanumeric content to at least one of the plurality of character positions. The character position of step (b) may or may not be one of the first and second character positions of step (a). This constitutes breadth and in no way makes claims 28, 39 and 50 indefinite under the second paragraph of 35 U.S.C. 112.

Independent claims 1, 10 and 19 have been amended by replacing the language noted in items A and B of paragraph 6.1 with the bar code orientation feature. With respect to items C and E (claims 1 and 5), the order of the steps or operations is a matter of breadth and not indefiniteness. With respect to item F1, independent claims 1, 10 and 19 have been amended to recite the bar code. With respect to F2, the ability to suppress a bar code allows the user to remove a default bar code from a label design.

With respect to claims 34, 35, 45, 46, 56 and 57 (noted at item L of paragraph 6.1), start and stop locations are a matter of breadth and not indefiniteness. With respect to claim 37 (noted at item M of paragraph 6.1), there is no need to recite an order in which the steps are performed. The order is a matter of breadth and not indefiniteness. With respect to claims 38, 49 and 60 (noted at item N of paragraph 6.1), the step of assigning a numerical sequence is positively recited. The Examiner’s question of “why” is irrelevant to the issue of indefiniteness. The numerical sequence is discussed in the specification, for example, beginning at page 10, line 27. Again, the point raised by the Examiner is breadth and not indefiniteness.

With respect to claims 29 through 31, 40 through 42 and 51 through 53 (noted at item K of paragraph 6.1), these claims do not recite a duplication of assigning a positional palette as contended by the Examiner. Claims 29, 40 and 51 recite that each of the positional palettes includes one or more attributes selected from a group that is listed in the claims. This is not duplication, but rather a qualification of the positional palette. Claims 30, 31, 41, 42, 52 and 53 merely recite that one or more of the character positions constitute a prefix or a suffix. Again, this is not duplication, but rather a qualification of the character positions.

With respect to claims 70 through 72 (noted at item R of paragraph 6.1), a step of printing the plurality of defined labels has been added to independent claims 70 and 72. Thus, the labels that are defined by user entry are printed or generated. Therefore, it is submitted that the indefiniteness is obviated by the amendment.

Accordingly, for the reasons set forth above it is submitted that the rejection of claims 1, 5, 6, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37 through 42, 44 through 46, 48 through 53, 55 through 57, 59, 60, 70 and 72 under the second paragraph of 35 U.S.C. 112 is obviated by the amendment.

At paragraph 7.1.1, the Office Action rejects claims 61 through 72 under 35 U.S.C. 101 because the invention claimed is directed to non-statutory subject matter. This rejection is moot as to claims 61 through 69 and 71, which have been canceled.

Independent claims 70 and 72 have been amended to recite a step of printing with a printer the defined plurality of labels on label stock. It is submitted that amended independent claims 70 and 72 qualify as a process under 35 U.S.C. 101. Thus, the plurality of labels defined by user entry in claims 70 and

72 are printed on label stock, which can be used in a concrete manner to produce a useful plurality of labels that has utility.

Independent claims 70 and 72 recite at least a post processing step, i.e., the printing with a printer of the labels on label stock, a practical use by a device, i.e., the printer, process steps that are beyond the manipulation of abstract ideas, the presenting and the printing steps or a concrete and tangible application, the process produces useful articles, namely a plurality of labels that are within the technological or useful arts.

At paragraph 7.2.3, the Examiner states, with reference to the rejection under the second paragraph 35 U.S.C. 112 that claims 1 through 72 recite elements or steps that “are not clearly and definitely interconnected to one another and therefore do not provide a useful system or method/process with in the meaning of 35 U.S.C. 101”. This statement is not a positive rejection of claims 1-72. Any such rejection made on this ground is untenable. The statutory provisions 35 U.S.C. 112 and 35 U.S.C. 101 are independent of one another. the failure of a claim to meet the requirements under either provision has no bearing on whether the claim meets the requirements of the other. In this case, the rejection under the second paragraph of 35 U.S.C. 112 has been refuted and demonstrated as untenable.

At paragraph 7.3, the Office Action rejects claims 61 through 72 under 35 U.S.C. 101 as being non-statutory because they lack substantial and practical utility. This rejection is moot as to claims 61 through 69 and 71, which have been canceled. Claims 70 and 72, as pointed out above, have been amended to recite a step of printing the defined plurality of labels on label stock. It is submitted that amended independent claims 70 and 72 have utility under 35 U.S.C. 101. Thus, the claimed process produces a plurality of labels on label stock, which are clearly useful to label and organize articles, such as computer disks. As such the process itself clearly has utility within the meaning of 35 U.S.C. 101.

For the reason set forth above, it is submitted that the rejection of claims 70 and 72 under 35 U.S.C. 101 is obviated by the amendment and should be withdrawn.

At paragraph 7.4, the Office Action rejects claims 1 through 72 under 35 U.S.C. 101 for failure to comply with the first paragraph of 35 U.S.C. 112 (claims 1 through 48), the second paragraph of 35 U.S.C. 112 (claims 1 through 72), 35 U.S.C. 102 (claims 1 through 7, 9 through 16, 18 through 25, 27 through 37, 39 through 48, 50 through 59 and 61 through 72) and 35 U.S.C. 103 (claims 8, 17, 26, 38, 49, and 60). This rejection is moot as to claims 2 through 4, 7 through 9, 11 through 13, 16 through 18, 20 through 22, 25 through 27, 32, 36, 43, 47, 54, 58, 61 through 69 and 71, which have been canceled.

This rejection is erroneous. The statutory provisions 35 U.S.C. 102, 35 U.S.C. 103, 35 U.S.C. 112 and 35 U.S.C. 101 are independent of one another. The failure of a claim to meet the requirements under any of these provisions has no bearing on whether the claim meets the requirements of any of the others. In this case, the rejections under the first and second paragraphs of 35 U.S.C. 112, 35 U.S.C. 102(e) and 35 U.S.C. 103 (a) have been refuted and demonstrated as untenable.

The Office Action rejects claims 61 through 69 under 35 U.S.C. 102(b) as anticipated by either U.S. Patent No. 5,128,861 to Kagami et al., hereafter Kagami, U.S. Patent No. 5,305,199 to LoBiondo et al., hereafter LoBiondo, or U.S. Patent No. 5,594,529 to Yamashita et al., hereafter Yamashita. The rejection is moot since claims 61 through 69 have been canceled.

The Office Action rejects claims 1 through 7, 9 through 16, 18 through 25, 27 through 37, 39 through 48, 50 through 59 and 70 through 72 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,085,126 to Mellgren III et al., hereafter

Mellgren. This rejection is moot as to claims 2 through 4, 7, 9, 11 through 13, 16, 18, 20 through 22, 25, 27, 32, 36, 43, 47, 54, 58 and 71, which have been canceled.

Independent claims 1, 10 and 19 have been amended to recite "assigning one of at least two rotational orientations to said plurality of elements of said bar code for said at least one label in response to at least one of said entries". Mellgren does not disclose or teach a bar code and, therefore lacks this step or operation.

Independent claims 28, 39 and 50 have been amended to recite a step or operation of assigning first and second positional palettes to at least first and second ones of the character positions, one character position at a time, of each label of a plurality of labels. Mellgren does not assign first and second positional palettes to at least first and second character positions, one character position at a time. Rather, Mellgren assigns a positional palette to all character positions at the same time. Thus, Mellgren lacks the step of assigning positional palettes as recited in amended independent claims 28, 39 and 50.

Independent claims 70 and 72 have been amended to recite the combination of the step of defining a plurality of labels and the step of printing the labels on label stock. Mellgren does not disclose the step of presenting an ad hoc interface to a user to define a plurality of labels that are unrelated in alphanumeric content or color in a single job as recited in amended claim 70. Mellgren produces a single label that is used to print multiple copies. Mellgren has no capability of producing a plurality of labels that are unrelated in content or color. Mellgren also lacks the capability of defining by user entry a plurality of labels that have related alphanumeric content and unrelated alphanumeric content in a single job as recited in amended claim 72.

The Examiner alleges in paragraph 8.2.2 that one of ordinary skill in the art would know that it is common practice to set forth to the user various options by presenting to the user a palette or a display showing a number of possible positions/colors/fonts available to the user. What one of ordinary skill knows is irrelevant to a consideration of novelty under 35 U.S.C. 102. The reference either discloses an element or it doesn't. If it doesn't, the reference does not anticipate. In this case, Mellgren lacks the steps discussed above.

The Examiner also alleges that any instruction to print one or more labels would in fact be recognized as a single print job as understood by one of ordinary skill in the art. What one of ordinary skill recognizes is irrelevant to a consideration of novelty under 35 U.S.C. 102. The reference either discloses an element or it doesn't. If it doesn't, the reference does not anticipate. In this case, Mellgren lacks the steps discussed above.

In paragraph 8.3, the Examiner contends that the claimed designation of labels is deemed non-functional descriptive material, citing *In re Gulack*, 217 USPQ 401. This case involved a rejection under 35 U.S.C. 103 and, therefore, is inapplicable to a rejection under 35 U.S.C. 102. Therefore, the contention is untenable.

For the reason set forth above, it is submitted that the rejection of claims 1, 5, 6, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37, 39 through 42, 44 through 46, 48, 50 through 53, 55 through 57, 59, 70 and 72 under 35 U.S.C. 102(e) as anticipated by Mellgren is obviated by the amendment and should be withdrawn.

At paragraph 9.1, the Office Action rejects claims 8, 17 and 26 under 35 U.S.C 103(a) as unpatentable over Mellgren as applied to claims 1 through 7, 9

through 16, 18 through 25, 27 through 37, 39 through 48, 50 through 59 and 70 through 72 and further in view of obvious variations.

The Examiner contends that Mellgren discloses a bar code without citing any location in Mellgren that supports such disclosure. A find search of Mellgren did not reveal any hit for "bar code". Since Mellgren does not disclose a bar code, the rejection is untenable.

For the above noted reason, it is submitted that the rejection of claims 8, 17 and 26 under 35 U.S.C. 103(a) is untenable and should be withdrawn.

At paragraph 9.2, the Office Action rejects claims 38, 49 and 60 under 35 U.S.C 103(a) as unpatentable over Mellgren as applied to claims 1 through 37, 39 through 48, 50 through 59 and 70 through 72 and further in view of the article, "1998 National Postal Forum"; Office Systems, November 1988, vol. 15, pages 54-56, hereafter Office Systems, as interpreted in view of U.S Patent No. 4,649,266 to Eckert, hereafter Eckert.

This rejection is obviated by the amendment to independent claims 28, 39 and 50 upon which claims 38, 49 and 60 are dependent since Mellgren lacks the step or operation of assigning a positional palette to a character position as discussed above.

In addition, the Office Action suggestion to use Office Systems and Eckert in combination with Mellgren is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at

the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 38, 49 and 60 under 35 U.S.C. 103(a) is obviated by the amendment and should be withdrawn.

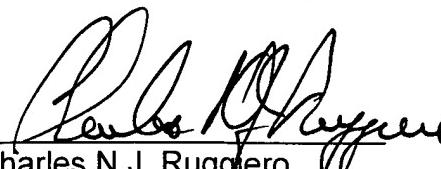
Newly presented claim 73 recites a method of forming labels with a computer having an input device. The method determines if a current job is an ad hoc job or a serial job. If an ad hoc job, one or more ad hoc displays are presented for a user to define an ad hoc job that includes a variety of labels having different content, some of the labels of the ad hoc job being unrelated to other labels of the ad hoc job. If a serial job, one or more serial display screens are presented for a user to define a serial job that includes a plurality of labels having different content and sequentially related to one another. In response to at least one entry of the input device, either the ad hoc job or the serial job is printed. None of the cited references teaches a method in which the user has the option to use either an ad hoc job or a serial job to define a plurality of labels. Accordingly, it is submitted that claim 73 distinguishes from the cited art and is, therefore, allowable.

It is respectfully requested for the reasons set forth above that the objection to the specification be withdrawn, that the rejections under 35 U.S.C. 112, 35 U.S.C. 102(b), 35 U.S.C. 102(e) and 35 U.S.C. 103(a) be withdrawn, that

claims 1, 5, 6, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37 through 42, 44 through 46, 48 through 53, 55 through 57, 59, 60, 70, 72 and 73 be allowed and that this application be passed to issue.

Respectfully Submitted,

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